REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-5, 7-24, 26-43, and 45-78 are pending in the application. No amendments are presented, thus, no new matter is added.

In the outstanding Official Action, Claims 39-43, 45-47 and 72-78 were rejected under 35 U.S.C. 101 as directed to non-statutory subject matter; Claims 1-4, 7-12, 15-18, 20-23, 26-31, 34-37, 39-42, 45-50, 53-56, 58-63, 65-70, and 72-77 were rejected under 35 U.S.C. 103(a) as unpatentable over Zhao et al. (U.S. Patent No. 6,141,753, hereinafter "Zhao") in view of Navarre et al. (U.S. Patent No. 6,442,611, hereinafter "Navarre"); Claims 5, 24, 43, 64, 71, and 78 were rejected under 35 U.S.C. 103(a) as unpatentable over Zhao in view of Navarre and further in view of Houser et al. (U.S. Patent No. 5,606,609, hereinafter "Houser"); Claims 13, 14, 32, 33, 51, and 52 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao in view of Navarre and further in view items upon which Official Notice has been taken; and Claims 19, 38, and 57 were rejected under 35 U.S.C. 103(a) as unpatentable over Zhao in view of Navarre and further in view of Stefik et al. (U.S. Patent No. 6,233,684, hereinafter "Stefik").

As an initial matter, and preliminary to filing a petition under 37 C.F.R. § 1.181 seeking withdrawal of the outstanding Final Rejection as premature,[1] Applicants provide the following discussion for facilitating supervisory review of the finality of the Official Action dated September 8, 2005, in accordance with MPEP § 706.07 (d).

As noted in the "Response to Arguments" portion of the Official Action, p. 17 of the Amendment filed February 2, 2005, states:

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[1] *See* MPEP § 706.07 (c).

> "The present application describes a non-limiting embodiment of
> the invention on page 18, lines 8-13, in which *watermark information*
> *is received from the printing entity.* For example, the application
> notes that the information can be the printer's serial number, the
> location of the printer, and/or the time and date to be printed to a
> printing engine. The cited references do not disclose such a feature."
> (emphasis added)

In response to this argument, the Official Action asserts:

> "Please note that the Examiner did not give these features any
> weight because they are not recited in the claims (at least the
> independent claims)."

However, Applicants' Claim 1 recites, *inter alia,* a method for managing documents,

comprising the step of:

> "...sending a merge command to a printing entity requesting that
> the document be printed with *watermark information received from*
> *said printing entity."*

Independent Claims 20, 39, 58, 65 and 72 were also amended in the Amendment filed

February 2, 2005, to recite a substantially similar features.

As such, the "final" Office Action of September 8, 2005 does not include a proper

rebuttal of Applicants positions with regard to the cited references outlined in the response of

February 2, 2005. In this regard the MPEP states

> "In order to provide a complete application file history and to
> enhance the clarity of the prosecution history record, **an examiner must**
> **provide** clear explanations of all actions taken by the examiner during
> prosecution of an application" *(See* MPEP § 707.07(f) (emphasis added)).

As noted above, the Official Action fails to address the above noted feature of

"requesting that the document be printed with *watermark information received from said*

printing entity". Thus, due to the Official Action's mistaken assertion that the relied upon

claim language does not appear in the claims, the necessary rebuttal has not been provided in

the Official Action of September 8, 2005. Therefore, the grounds of rejection have not been

clearly developed to such an extent that the Applicants can readily judge the advisability of

an appeal. Accordingly, Applicants respectfully submit that the finality of the Official Action

dated September 8, 2005 is premature and should be withdrawn in the next communication.

Additionally, Applicants respectfully request that the Finality of the outstanding

Official Action of September 8, 2005, be withdrawn, as the Official Action asserts a new

grounds for rejection not necessitated by Applicants' amendment of the claims. MPEP §

706.07 (a), states that

> "...second or any subsequent actions on the merits shall be
> final, except where the Examiner introduces a new ground of rejection
> that is neither necessitated by applicant's amendment of the claims nor
> based on information submitted in an information disclosure
> statement..." (emphasis added)

The outstanding Official Action clearly asserts new grounds for rejection by rejecting

Claims 39-43, 45-47 and 73-78 under 35 U.S.C. 101, as directed to non-statutory subject

matter. Such a rejection was not necessitated by applicant's amendment of the claims since

the amendments presented in these claims fails to effect the statutory class in which the

claims reside.

Therefore, as Applicants amendments failed to necessitate the new grounds of

rejected presented on the outstanding Official Action, and the new grounds of rejection cited

in the outstanding Official Action are not based on information submitted in an information

disclosure statement, Applicants respectfully submit that the Finality of the outstanding

Official Action is improper, and be withdrawn.

In the outstanding Official Action, Claims 39-43, 45-47 and 72-78 were rejected

under 35 U.S.C. 101 as directed to non-statutory subject matter, as noted above. Applicants

respectfully traverse this rejection.

The outstanding Official Action, at p. 4, states:

> "Claims 39 and 72, while defining a computer program product
> does not define a 'computer readable medium' and is thus non-
> statutory for that reasons... The Examiner suggests amending the

claim to embody the program on a 'computer readable medium' in order to make the claim statutory."

However, independent Claims 39 and 72 both recite, a computer program product, comprising:

"a computer storage medium and a computer program code mechanism embedded in the computer storage medium for causing a computer to manage documents over a computer network, the computer program code mechanism..."

Thus, independent Claims 39 and 72 both recite that the "computer program code" is embedded in the "computer storage medium", as recommended in the outstanding Official Action. Accordingly, it is respectfully requested that this rejection be withdrawn.

MPEP § 2106 discusses statutory subject matter in relation to data structures of a computer readable medium. Particularly, MPEP § 2106 provides,

a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Thus, based on the clear language of this section, independent Claims 39 and 72 are statutory as they define a functionality of which is realized based on the interrelationship of the structure to the medium and recited hardware components.

Accordingly, Applicants respectfully submit, as noted above, that the rejection under 35 U.S.C. § 101 should be withdrawn. However, if the rejection under U.S.C. § 101 is to be maintained, applicants respectfully request that the Examiner provide an explanation of the rejection in view of the guidelines of MPEP § 2106.

The outstanding Official Action rejected independent Claims 1, 20, 39, 58, 65 and 72 under 35 U.S.C. 103(a) as unpatentable over Zhao in view of Navarre. The Official Action cites Zhao as disclosing the Applicant's invention with the exception of receiving, at a

centralized document manager, a request for a document from a remote user.[2] The Official

Action cites Navarre as disclosing this claimed feature, and stated that it would have been

obvious to one of ordinary skill in the art at the time of the invention to combine the

teachings of the cited references to arrive at the Applicant's claims. Applicants respectfully

traverse this assertion.

Independent Claim 1 relates to a method for managing documents, in which a request

is received at a centralized document manager server from a remote user. Based on the

request, the document manager server selects an application service provider amongst a

plurality of application service providers, and forwards the request to the selected application

service provider. The document is then retrieved from the selected application service

provider, and a merge command is sent to a printing entity requesting that the document be

printed *with watermark information received from the printing entity*

The requirements for establishing a *prima facie* case of obviousness as set forth in

MPEP 2143 include (1) there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the reference or to combine reference teachings, (2) there must be a reasonable

expectation of success, and (3) the reference (or references when combined) must teach or

suggest all of the claim limitations. The Applicant submits that a *prima facie* case of

obviousness cannot be established in the present case because the reference, either taken

singularly or in combination, do not teach or suggest all of the claim limitations.

As noted above, independent Claim 1 recites, *inter alia,* a method for managing

documents, comprising the step of:

> "…sending a merge command to a printing entity requesting that
> the document be printed with *watermark information received from
> said printing entity*."

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[2] Outstanding Official Action, p. 5.

Independent Claims 20, 39, 58, 65 and 72 also recite substantially similar features, but are each directed to alternative embodiments of the invention. Accordingly, the arguments presented below apply to all the pending independent claims.

The present application describes a non-limiting, exemplary embodiment of the invention on page 18, lines 8-13, in which watermark information is received from the printing entity. For example, the application notes that the information can be the printer's serial number, the location of the printer, and/or the time and date to be printed to a printing engine. The cited references, neither alone, nor in combination teach or suggest such a feature.

Turning to the primary reference, Zhao describes a technique for the secure distribution of digital representations that combine encryption and watermarking.[3] In Zhao, a request for a document can be sent from a copy client (119i) to a copy server (103j), and the copy server then distributes the digital representation, which may include a watermark added by the copy server, to the copy client.[4] Once the copy client receives a copy of the digital representation they may perform various operations such as decoding, playing, printing, making a local copy, or making a derivative work of the digital representation.[5]

Thus, Zhao specifically describes that watermark information may be added to the digital representation at the copy server[6], but fails to teach or suggest "...requesting that the document be printed with *watermark information received from said printing entity*", as recited in the pending independent claims. Zhao does describe that the digital representation may be printed, but fails to teach or suggest receiving information from a printing entity, much less that *watermark information is received from the printing entity*. Accordingly, Zhao fails to teach or suggest this above noted claimed feature.

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[3] Zhao, abstract.
[4] Id., col. 6, lines 34-49, and col. 7, lines 1-14.
[5] Id.
[6] Id., col. 6, lines 18-33.

Turning to the secondary reference, <u>Navarre</u> describes a system and method for executing a request from a client application where the client application sends a single request to a gateway application, which then converts the request into appropriate data access transactions.[7] The data access transactions are transmitted from the gateway to a plurality of server applications, and the responses from the server application are processed to form a single integrated response from the gateway to the requesting client.[8]

However, <u>Navarre</u> is silent regarding the use of watermarks or the printing of a document. Thus, <u>Navarre</u> fails to teach or suggest the ***receipt of watermark information from a printing entity***, as recited in the pending independent claims.

Since neither <u>Zhao</u> nor <u>Navarre</u>, neither alone, nor in combination teach or suggest "...requesting that the document be printed with ***watermark information received from said printing entity***", the proposed combination of these references fails to render Claims 1, 20, 39, 58, 65, and 72 of the present application obvious. Thus, the Applicants respectfully request the withdrawal of the obviousness rejections of Claims 1, 20, 39, 58, 65, and 72.

The dependent claims are considered allowable for the reasons advanced for the independent claims from which they depend. The dependent claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of the respective independent claim.
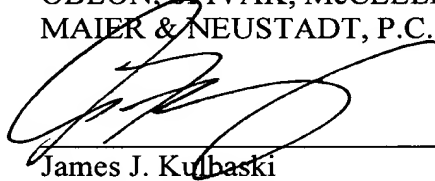
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[7] <u>Navarre</u>, abstract.
[8] <u>Id.</u>, col. 2, lines 3-24.

Consequently, in light of the foregoing comments, it is respectfully submitted that the

invention defined by Claims 1-5, 7-24, 26-43, and 45-78 is patentably distinguishing over the

applied references. The present application is therefore believed to be in condition for formal

allowance and an early and favorable reconsideration of the application is therefore

requested.

Respectfully submitted,

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